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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,062	06/15/2001	Holger Birk	016790-0422	5177

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EXAMINER
ROBINSON, MARK A

ART UNIT	PAPER NUMBER
2872	

DATE MAILED: 02/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/881,062	Applicant(s) BIRK ET AL.	
	Examiner Mark A. Robinson	Art Unit 2872	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 November 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-33* is/are pending in the application.

4a) Of the above claim(s) *12,14,21 and 24* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11,13,15-20,22,23 and 25-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *15 June 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *7,8* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of the species of fig. 3 in Paper No. 10 is acknowledged.

Applicant has stated that claims 1-3,5-11,15-18 and 26-33 read on the elected species. However, it is seen that the only claims *not* readable on the elected species are claims 12,14,21,24 (directed to the end of the fiber serving as the illumination pinhole). Thus, claims 1-11,13,15-20,22,23 and 25-33 are believed to read on the elected species and will be examined on the merits as follows.

Claims 12,14,21 and 24 are withdrawn from consideration as being drawn to non-elected subject matter.

Claim Rejections - 35 USC § 112

2. Claims 7 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In these claims it is unclear how the attenuating means can consist of all of the named elements since each of these elements is itself a means for performing this function.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless
>
> (e) the invention was described in-
> (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
> (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. Claims 1-3,5-7,19,20,22 and 28-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Kafka et al.

Kafka discloses a microscope including a pulsed laser(12), means for imaging light onto a specimen(18,20), and an optical fiber(14) comprising photonic band gap material which spectrally spreads light passing therethrough. Note also that means for wavelength attenuation are disclosed in col. 2 lines 60-68.

Regarding claim 29, note that Kafka's structure may be considered as a scanning confocal microscope in a similar manner as the elements listed in these claims.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 4,8,23,25-27 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kafka et al.

Regarding claims 4,23,25-27 and 33, although not taught by Kafka, tapered optical fibers are well known in the art. It would have been obvious to the ordinarily skilled artisan at the time of invention to use a tapered fiber with Kafka's system for the advantages and/or features provided by a tapered fiber, i.e. control of the transmitted mode or to enable coupling with other optical elements downstream of the fiber.

Regarding claim 8, although not taught by Kafka, use of a known control loop for the light source would have been obvious in order to provide consistent output from the laser.

7. Claims 9-11,13 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kafka et al in view of Simon et al.

Kafka meets the limitations of these claims as discussed above, but does not specifically teach a detector for receiving light from the specimen. However, detectors are commonly used with microscope systems and an example is shown by Simon in figs. 1 and 2. It would have been obvious to the ordinarily skilled artisan at the time of invention to include detectors with Kafka's system in order to enable detection of light coming from the specimen.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-11,13,15-20,22,23,25-33 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 7-10, etc. of copending Application No. 09/880,825, claims 15,16,18, etc. of copending Application No. 09/881,046, claims 5,9, etc of copending Applicant No. 09/881,048, claims 5-13 of copending Application No. 09/881,049, claims 17-19, etc. of copending Application No. 09/881,212, and claims 6,7,11, etc. of copending Application No. 09/882,355. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application are merely broader than or are obvious variations of the claims of the copending applications.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ashkin shows a laser in conjunction with a dispersing optical fiber.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Robinson whose telephone number is (703) 305-3506.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cassandra Spyrou can be reached at (703) 308-1687. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

MR

1/30/03

MARK A. ROBINSON
PRIMARY EXAMINER